



05-18-06

AFH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re: Application of:

Date: May 15, 2006

Allen Berger, Jr.

Serial No.: 10/669,900

Art Unit: 3635

Filed: September 25, 2003

Examiner: Robert J. Canfield

For: "SURFACE MOUNT WINDOW FOR DOORS"

Atty. Dkt. No. 230199.3

BRIEF (TWICE AMENDED) FOR APPELLANT

Board of Patent Appeals and Interferences

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, Virginia 22313-1450

Honorable Board Members:

This is an appeal from the Examiner of Art Unit 3635 finally rejecting claims 1 and 4 on appeal, and for which an amendment after final rejection was presented to the Examiner for the purposes of this appeal. The claims on appeal are included in the Appendix (page 8).

I. REAL PARTY IN INTEREST.

The Applicant, Allen Berger, Jr., is the real party in interest.

1 **II. RELATED APPEALS AND INTERFERENCES.**

2
3 There are no other related appeals or interferences.
4

5 **III. STATUS OF CLAIMS.**

6
7 The following claims were filed with the continuation application
8 (with the preliminary amendment) for the Surface Mount Window for
9 Doors:
10

11 1. A window assembly for garage doors, comprising:
12

13 A) a transparent panel having an external surface and an internal
14 surface, said external surface including a peripheral flange member making
15 said external surface larger than said internal surface with respective
16 external and internal peripheral edges, and said peripheral flange member
17 further including a peripheral underside surface that comes in abutting
18 contact against the peripheral external surface adjacent to an opening in a
19 garage panel with cooperative dimensions to permit said internal surface to
20 go through; and

1 B) means for mounting said transparent panel on said garage
2 panel.

3
4 4. The window assembly set forth in claim 1 wherein said means
5 for mounting said transparent panel on said garage panel includes:

6
7 C) an external frame assembly mounted on said garage panel
8 around said external peripheral edge.

9
10 This application is a continuation of application serial No. 10/244,482
11 filed on September 17, 2002. Initially, Applicant filed a preliminary
12 amendment leaving two claims in this patent application. Claim 1 is
13 derived from the parent application and new claim 4. The amendment
14 filed on April 21, 2005, added the words "coplanarly extending" for
15 clarification purposes. The amendment after final rejection (permitted by
16 the examiner) replaced the word "go" with pass and added the words said
17 opening also for clarification purposes. The two claims are rejected.

IV. STATUS OF AMENDMENTS.

The Examiner entered the amendment mentioned above. The two pending claims read as included in the appendix.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER.

The present invention relates to a novel surface mount window for doors, such as overhead garage doors. The invention allows a user to readily mount a window to a panel door that can withstand substantial wind loads. In figure 2 a garage door panel P with an opening shows how the transparent panel partially passes through with peripheral flange 22 staying on one side of the panel P in contact with the latter with underside 24.

The means for mounting the transparent panels is disclosed in page 4 of the specifications including fastener members 80 that coact with frame assemblies 40 and 60, as best seen in figure 2.

1 **VI. GROUNDS FOR REJECTION TO BE REVIEWED**
2 **ON APPEAL**
3

4 Whether the claims are anticipated by U.S. patent No. 5,950,398
5

6 **VII. ARGUMENTS.**
7

8 References relied by the Examiner:
9

10	<u>Patentee</u>	<u>Patent No.</u>	<u>Publication Date</u>
11	Hubbard	5,950,398	September 14, 1999

12

13 The Examiner has rejected claims 1 and 4 under 35 U.S.C. §102 (b) as
14 being anticipated by Hubbard. Applicant respectfully disagrees.
15

16 **1. The cited reference fails to anticipate the claimed invention.**
17

18 The Examiner has rejected claims 1 and 4 under 35 U.S.C. 102(b), as
19 being anticipated by U.S. patent No. 5,950,398 to Hubbard. Applicant
20 respectfully disagrees. Hubbard shows inner pane or interior glazing 18
21 that the Examiner has equated to Applicant's internal surface. Inner pane

1 18, however, does not pass through the opening of sash 10. Rather, pane 18
2 is kept "within" the sash, on rabbet 12 abutting against "inner" face 14.

3
4 Also, the claimed invention includes peripheral flange members that
5 come in abutting contact against the peripheral external surface adjacent to
6 opening. Hubbard's external surface 17 is also received within the
7 opening, which is contrary to what is claimed herein. In sum, Hubbard
8 teaches away from this invention.

9
10 The Examiner states: "If one considers the opening to be defined as
11 the space between reveal 16 and face 14..." p.2 of Advisory Action Before
12 the Filing of an Appeal Brief. This assumption fails to take into
13 consideration the explicit disclosure of the outer surface 13 of Hubbard's
14 double glazed pass-by window unit 11. The real opening of the sash is
15 defined by its outer surface 13. The rabbet 12 is interiorly defined and it is
16 inside the opening. Therefore, the Examiner's assumption is improper.

17
18 In claim 1 the peripheral flange comes in contact with the external
19 surface. For Hubbard to anticipate Applicant's claimed invention, the
20 outside panel 17 needs to have a peripheral flange that comes in abutting
21 contact with outer surface 13 and this is not disclosed in Hubbard.

1 Hubbard uses two panes 17 and 18. Applicant only utilizes one.

2 Even if we were to combine pane 18 with pane 17, the combination does
3 not pass through the opening of a garage door panel opening. Panel 18 is
4 shown in figures No. 3 to be inside the sash.

5
6 The Examiner's assumption is not inherent in the type of product
7 described in Hubbard. Rabbits are used for recessing the panels in a sash.
8 This is not intended in the present invention. In this regard, the CCPA has
9 stated that "[I]nherency, however, may not be established by probabilities
10 or possibilities. The mere fact that a certain thing may result from a given
11 set of circumstances is not sufficient." *In re Oerlich*, 666 F.2d 578, 581, 212
12 U.S.P.Q. 323, 326 (CCPA 1981). Therefore, the Examiner's analogy is not
13 saved by the limited application of inherency principle to overcome the
14 burden of establishing anticipation.

15
16 There is no evidence in the record that one with ordinary skill will
17 equate the internal opening defined by a rabbit or reveal 14 with the true
18 opening of a sash. Nor that causing a panel to come in abutting
19 relationship with reveal 14 puts the claimed invention in the hand of one
20 skilled in the art. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621
21 (Fed. Cir. 1985).

VIII. CLAIMS APPENDIX

1. A window assembly for garage doors, comprising:

A) a transparent panel having an external surface and an internal surface, said external surface including a peripheral flange member making said external surface larger than said internal surface with respective external and internal peripheral edges, and said peripheral flange member further including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said internal surface to pass through said opening; and

B) means for mounting said transparent panel on said garage panel.

4. The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes:

C) an external frame assembly mounted on said garage panel around said external peripheral edge.

1 **IX. EVIDENCE APPENDIX.**

2 No evidence was adduced in this application.

1 **X. RELATED PROCEEDINGS APPENDIX**

2 There are no related proceedings.

1 **XI. CONCLUSION.**

2

3 When this invention and the application's claims are fully analyzed

4 and interpreted as explained above, it will be apparent that there is a good

5 and clear difference between this invention and the cited prior art. When

6 all factors are taken into consideration and given their due weight, it is

7 believed that the Board of Appeals will be able to reverse the Examiner and

8 such is now requested.

9

10 Kindly charge or credit our Deposit Account No: **19-0129** for the

11 pertinent fees to cover the appeal brief fee.

12

13 Respectfully submitted,

14

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of:
Dab Door Company, Inc.

Date: May 15, 2006

Filing Date: September 25, 2003

Serial No. 10/669,900

Attorney Dkt. No. 230199.3

Title: "SURFACE MOUNT WINDOW FOR DOORS"

EXPRESS MAIL CERTIFICATE

"Express Mail" Mailing Label No: E V 5 2 8 5 5 1 6 2 U S

Date of Deposit: May 16, 2006

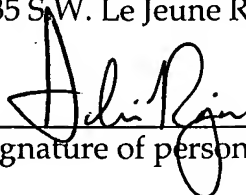
I hereby certify that this paper(s) or fee is hereby being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service pursuant to 37 C.F.R. §1.10 on the date indicated above and is addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450**. I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of this application, document, registration or patent resulting therefrom.

Papers included:

- 1) Brief (Twice Amended) for Applicant; and
- 2) postcard.

Adrian Rojas, Patent Dept.

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Signature of person mailing paper(s) or fee